

### **Remarks**

The Applicants have incorporated the subject matter of Claim 2 into Claim 1. Claim 2 has accordingly been cancelled.

Turning now to the merits, the Applicants acknowledge the rejection of Claims 1, 4, 7 and 9 as being anticipated by Greener. The Applicants respectfully submit that the amendment to Claim 1 renders that rejection moot.

The Applicants acknowledge the rejection of Claims 3 and 10 as being obvious over Greener in view of White. Again, the Applicants respectfully submit that the amendment to Claim 1 renders that rejection moot.

The sole remaining rejection lies with the rejection of Claims 2, 5, 6 and 8 as being obvious over Greener. The Applicants note the Examiner's frank acknowledgment that Greener does not disclose the surface roughness of Claim 2, the onset temperature of dielectric loss of Claim 5, the insulation volume resistance of Claim 6 and the thermal shrinkage of Claim 8. The Applicants agree.

The Applicants also note with appreciation the Examiner's helpful comments with regard to those specific characteristics and that it "would be readily determined through routine experimentation by one having ordinary skill in the art, depending on the desired end results." However, it is the Applicants who specifically teach those of ordinary skill in the art in the Application how to do those things.

Unfortunately, how one determines those characteristics is not the test of obviousness. Moreover, the fact that they can be determined is also not the test of obviousness. The appropriate test is whether Greener teaches or suggests those characteristics or modifications to obtain those

characteristics to one of ordinary skill in the art. The Applicants respectfully submit that Greener does not teach or suggest those characteristics or any such modifications to one of ordinary skill in the art.

Careful scrutiny of the entire Greener disclosure reveals that there is not one word concerning surface roughness or that surface roughness has any importance at all. This is especially true in the context of the photographic film use of the Greener film, as opposed to the capacitor having high resistance film of the invention. As a consequence of the total failure of Greener to even mention surface roughness, it inherently follows that one of ordinary skill in the art would have no motivation at all to ensure that the surface roughness is within the claimed range of 10 nm to 140 nm. The Applicants ask the question: How can it be obvious to experiment with surface roughness when not one word is mentioned concerning surface roughness in the only reference over which the claims are rejected?

The same logic applies to the onset temperature of dielectric loss, the insulation volume resistance and thermal shrinkage. Careful scrutiny of the entire Greener disclosure reveals that there is not one word concerning these claimed features. Again, it inherently cannot be obvious to provide for such characteristics when the only reference cited against the claims fails to mention these characteristics at all.

Moreover, the Applicants respectfully submit that one of ordinary skill in the art would not have a reasonable expectation that those characteristics would be present in the Applicants' films versus those of Greener. Although there are certain similarities in the production methodology, there are other aspects of production that are quite different and can and do have significant influence on the resulting product.

For example, the Applicants' methodology provides for not only the biaxial stretching, but also heat treatment performed after such stretching within specified temperatures and specified lengths of time. However, additionally, a relaxation step of selected percentages in either or both of the transverse and machine directions can be performed followed by a cooling step. The Applicants specifically teach in the upper portion of page 25 of their Specification, for example, that such a relaxation step is helpful in obtaining the polyester film of the invention for use as a heat-resistant capacitor.

Careful scrutiny of the entire Greener disclosure reveals that there is no such provision for a relaxation treatment. As a consequence, one of ordinary skill in the art would have a reasonable expectation that the films of the invention can be sharply different from those of Greener. Accordingly, this provides additional reasons why the claimed characteristics as set forth in the solicited claims would not be obvious to one of ordinary skill in the art based on the Greener disclosure.

These points are reinforced by reference to the Applicants' Specification. The Applicants invite the Examiner's attention to the paragraph spanning pages 13 and 14. It recites that, if the surface roughness  $R_a$  is less than 10 nm, the polyester film used as a dielectric in a capacitor tends to partially deteriorate and yield poor charging life. It further recites that, if the surface roughness is more than 140 nm, the resulting capacitor lowers its insulation breakdown voltage and, therefore, a high performance capacitor is difficult to obtain.

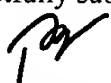
Examples 3, 8 and 9 show that, if surface roughness  $R_a$  is less than 10 nm or more than 140 nm, insulation breakdown voltage of capacitor at 125°C and charging life of capacitor at 125°C are inferior in Examples 8 and 9, as compared with original Example 3. Also, the third paragraph of page 12, Example 1 and Comparative Example 1 recites that the glass transition temperature of the

polymer influences insulation breakdown voltage of the capacitor and the charging life of the capacitor.

The Applicants, therefore, respectfully submit that the claimed characteristics would not be obvious to one of ordinary skill in the art based on Greener. Withdrawal of the 35 U.S.C. §103 rejection is respectfully requested.

In light of the foregoing, we respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



T. Daniel Christenbury  
Reg. No. 31,750  
Attorney for Applicants

TDC:lh  
(215) 656-3381